

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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GMA ACCESSORIES, INC.

Plaintiff,

- against -

QUIKSILVER, INC., NORDSTROM, INC., Civil Action No: 07-CV-11527 (VM) (RLE)
SWELL, INC, AND JILL STUART, INC.,

Defendants.
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DECLARATION OF STEPHEN W. FEINGOLD

Stephen W. Feingold declares under penalty of perjury as follows:

1. I am a member of the law firm Day Pitney LLP in New York, New York. Day Pitney LLP is counsel for Defendant Quiksilver, Inc. ("Quiksilver") in the above-captioned action.

2. Exhibit A is a summary chart indicating trademark actions instituted by or against Plaintiff, GMA Accessories, Inc. ("GMA") involving GMA's CHARLOTTE mark in either federal court or before the Trademark Trial and Appeal Board. This chart was created by our review of certain online databases by searching for GMA Accessories, Inc. and accurately reflects the information available from those databases on the dates they were searched during the last thirty (30) days. These databases, such as the uspto.gov database for opposition proceedings, are often under inclusive, it is therefore possible that there are other proceedings involving GMA and its CHARLOTTE mark which are not included. These databases are also often not maintained on a regular basis, as such this chart may not reflect the most recent information in the case. Notably, document requests calling for production of this information

were served on Plaintiff, but such information has not been produced due to objections that documents evidencing other cases brought by or against GMA relating to its CHARLOTTE mark are not relevant and beyond the scope of this litigation, and referring Defendants to the appropriate government office to obtain that information which is publicly available.

3. Exhibit B is a true and accurate copy of GMA's Memorandum of Law in Support of Defendant's Motion to Dismiss from *Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.*, Civ. No. 07CV9578 (CM), Dkt. No. 8 (S.D.N.Y. Nov. 19, 2007).

4. Exhibit C is a true and accurate copy of the transcript from a court conference held by Judge Colleen McMahon with counsel for Sanei Charlotte Ronson LLC and GMA on February 15, 2008 in *Sanei Charlotte Ronson LLC v. GMA Accessories, Inc.*, Civ. No. 07CV9578 (CM), during which Judge McMahon denied GMA's motion to dismiss Sanei Charlotte Ronson's claims for trademark misuse and fraud on the United States Patent and Trademark Office ("PTO").

5. Exhibit D is a true and accurate copy of the registration certificate issued by the PTO for Reg. No. 2,535,454 for GMA's CHARLOTTE mark in class 25.

6. Exhibit E is a true and accurate copy of the registration certificate issued by the PTO for Reg. No. 2,217,341 for GMA's CHARLOTTE mark in class 18.

7. Exhibit F is a true and accurate copy of PTO's Trademark Applications and Registrations Retrieval (TARR) status report of Reg. No. 1,135,037 for GMA's cancelled CHARLOTTE mark as of July 11, 2008.

I declare under penalty of perjury that the foregoing is true and correct.

Date: July 14, 2007

s/ Stephen W. Feingold

Stephen W. Feingold

Member of Day Pitney LLP

EXHIBIT A

Case Name	Court & Filing Date	Plaintiff	Defendant(s)	Nature of the Dispute	Preliminary Posture	Status
Sam Charlotte Fashion LLC v.GMA Accessories, Inc.	S.D.N.Y.: October 4, 2007	Sam Charlotte Fashion LLC	GMA Accessories, Inc.	Plaintiff brought suit for non-infringement, invalidity and ownership of GMA's rights to the trademark "Charlotte". Defendant, GMA raised counter-claims for trademark infringement. 1. Registration #2,216,405, Class 26, Mark "Charlotte"; 2. Registration #2,217,341, Class 16, Mark "Charlotte"; 3. Registration #2,385,454, Class 26, Mark "Charlotte"; 4. Registration #2,361,025, Class 9, Mark "Charlotte"; and 5. Registration #3,292,356, Class 22, Mark "Charlotte".	01/22/2008 – Judge signs an Order Referring Case to a Magistrate Judge for settlement. 02/28/2008 – Order of Discontinuance.	The matter was closed on February 28, 2008. Magistrate Judge R.C. Eason signed an Order of Discontinuance with prejudice.
GMA Accessories v. Lauren Merlin Productions, LLC	S.D.N.Y.: October 26, 2007	GMA Accessories, Inc.	Lauren Merlin Productions, LLC	The plaintiff brought an action for declaratory judgment that plaintiff's use of the name "Charlotte Fashion", a personal styling service, does not infringe upon any rights GMA holds in the name "Charlotte". The defendant also seeks an injunction against plaintiff's use of the name "Charlotte" in its business, as well as a declaration that plaintiff's name "Charlotte Fashion" is a common-law trademark. Plaintiff's trademarks were allegedly misappropriated by defendant. Thus, on March 26, 2008 GMA filed an injunction prior to trial, asserting that defendant had used GMA's trademarks several times without permission. Specifically, plaintiff asserted: 1. Registration #2,216,405, Class 26, Mark "Charlotte"; 2. Registration #2,217,341, Class 16, Mark "Charlotte"; 3. Registration #2,385,454, Class 26, Mark "Charlotte"; 4. Registration #2,361,025, Class 9, Mark "Charlotte"; 5. Registration #3,292,356, Class 22, Mark "Charlotte"; 6. Registration #2,412,590, Class 26, Mark "Charlotte & Friends"; 7. Registration #2,444,201, Class 26, Mark "Charlotte & Friends"; 8. Registration #2,442,376, Class 9, Mark "Charlotte & Friends"; 9. Registration #2,442,319, Class 9, Mark "Charlotte & Friends"; 10. Registration #2,442,315, Class 9, Mark "Charlotte & Friends".	11/19/2008 – GMA files a motion to dismiss for lack of jurisdiction, failure to state a claim, and failure to comply with Rule 8(a). 04/11/2008 – Plaintiff files a Motion for Summary Judgment. 04/18/2008 – Order referring the case to a Magistrate Judge for settlement. 05/22/2008 – Endorsed Notice to Judge that the settlement has not yet been consummated and thus the agreement is rescinded.	The matter was closed on June 13, 2008 pursuant to an order and stipulation of the parties.
GMA Accessories v. Lauren Merlin Productions, LLC	S.D.N.Y.: November 30, 2007	GMA Accessories	Lauren Merlin Productions, LLC	Plaintiff brought suit against defendant, Lauren Merlin Productions, LLC, for trademark infringement of the mark "Charlotte". 1. Registration #2,216,405, Class 26, Mark "Charlotte"; 2. Registration #2,217,341, Class 16, Mark "Charlotte"; 3. Registration #2,385,454, Class 26, Mark "Charlotte"; 4. Registration #2,361,025, Class 9, Mark "Charlotte"; and 5. Registration #3,292,356, Class 22, Mark "Charlotte".	01/10/2008 – Order referring the matter to a Magistrate Judge for settlement negotiations pursuant to the terms of Agreement. 02/26/2008 – Order of Dismissal with prejudice provided that the Court retains jurisdiction over the settlement.	The matter was closed on February 26, 2008. Magistrate Judge A.J. Park signed an Order of Dismissal with prejudice.
Fossil Partners L.P. v.GMA Accessories, Inc.	N.D.N.Y.: March 4, 2008	Fossil Partners L.P.	GMA Accessories, Inc.	Fossil Partners, L.P., plaintiff, seeks a declaratory judgment pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2001, regarding the use of the "Charlotte" mark and whether such use constitutes trademark infringement of GMA Accessories' rights.	05/19/2008 – Fossil Partners files an Agreed Motion for Dismissal. 05/15/2008 – Order granting Motion for Dismissal with Prejudice. Any and all claims by Fossil Partners L.P. against GMA Accessories are dismissed.	The matter was closed on May 19, 2008. Magistrate Judge A.J. Park signed an Order of Dismissal with prejudice.
Guru Derm, Inc. v.GMA Accessories, Inc.	CL.G.A.: May 6, 2008	Guru Derm, Inc.	GMA Accessories, Inc.	GMA Accessories filed an Offer of Judgment on May 19, 2008, releasing Guru Derm from any previous liability arising from the use of the mark "Charlotte". Guru Derm, Inc. filed a Notice of Offer of Judgment on May 20, 2008, accepting the Offer of Judgment. 05/22/2008 – Plaintiff, Guru Derm, files a Notice of Acceptance of Offer of Judgment. 06/02/2008 – Judge grants Judgment in favor of GMA Accessories. The case is terminated.	The matter was closed on June 02, 2008. Judge R.C. O'Connor signed an Order of Dismissal. Any claims by Fossil Partners L.P. against GMA Accessories are dismissed with prejudice.	The matter was closed on June 13, 2008 pursuant to an order and stipulation of the parties.

Case Name	Court & Filing Date	Plaintiff	Defendant(s)	Nature of the Dispute	Presented Posture	Status
GMA Accessories, Inc. v. OI Lynguard A/S	TTAB: October 20, 2013	GMA Accessories	OI Lynguard A/S	OI Lynguard filed an application on October 2, 2001 to register the mark "Charlotte Lynguard" in Class 024.	* 09/10/2003 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Lynguard." * 09/26/2003 - GMA Accessories files an Opposition to registration of the mark "Charlotte Lynguard." * 10/21/2004 - OI Lynguard files a Notice of Opposition to registration of the mark "Charlotte Lynguard." * 02/29/2004 - TTAB denies that application has been abandoned and dismisses the opposition with prejudice.	The matter was dismissed on February 3, 2014, March 5, 2014, and November 18, 2014.
GMA Accessories, Inc. v. RUJ Basketball LLC	TTAB: January 15, 2004	GMA Accessories	RUJ Basketball LLC	RUJ Basketball filed an application on May 1, 2003 to register the mark "Charlotte Blocks" in Class 025.	* 07/17/2003 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Blocks." * 07/17/2003 - GMA Accessories files an Opposition to registration of the mark "Charlotte Blocks." * 05/21/2004 - RUJ Basketball files an Opposition with prejudice.	The matter was dismissed on March 30, 2006.
GMA Accessories, Inc. v. RUJ	TTAB: January 15, 2004	GMA Accessories	RUJ Basketball LLC	RUJ Basketball filed an application on May 1, 2003 to register the mark "Charlotte Blocks" in Class 025.	* 07/17/2003 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Blocks." * 07/17/2003 - GMA Accessories files an Opposition to registration of the mark "Charlotte Blocks." * 05/21/2004 - RUJ Basketball files an Opposition with prejudice.	The matter was dismissed on March 30, 2006.
GMA Accessories, Inc. v. GC Trademarks, LLC	TTAB: October 27, 2004	GMA Accessories	GC Trademarks	GC Trademarks filed an application on August 11, 2003 to register the mark "Good Charlotte" in Classes 005, 009, 016, 025, 026, 034, and 041.	* 02/20/2004 - GMA files a Notice of Opposition to registration of the mark "Charlotte Blocks." * 02/20/2004 - Notice and trial dates sent to parties. * 02/20/2005 - GMA accessories requests a Motion to Reopen and for Summary Judgment. * 03/04/2005 - TTAB denies the request to reopen in summary and dismisses GMA Accessories' Opposition with prejudice.	The matter was dismissed on March 30, 2006.
GMA Accessories, Inc. v. The Black & Decker Corp.	TTAB: July 28, 2005	GMA Accessories	Black & Decker	Black & Decker Corp. filed an application on July 12, 2004 to register "Charlotte" in Class 005.	* 02/20/2005 - USPTO issues a Notice of Publication for the registration of the mark "Good Charlotte" in Classes 005 & 006 because it is similar to registered marks owned by GMA. * 02/20/2005 - Notice and trial dates sent to parties. * 02/20/2005 - The trademark registration for "Good Charlotte" is canceled and the application is restored to pending status. * 03/17/2005 - GMA Accessories files a Motion for Summary Judgment against GC Trademarks. * 04/14/2007 - TTAB grants Opposer's motion for Summary Judgment to cancel the application. * 04/18/2007 - The application to trademark "Good Charlotte" is abandoned.	The matter was filed on April 16, 2007 when the trademark application was abandoned.
GMA Accessories, Inc. v. C. Rouson, LLC	TTAB: October 31, 2005	GMA Accessories	C. Rouson	C. Rouson Inc. filed an application on October 28, 2004 to register the mark "Charlotte Ronson" in Class 014.	* 02/11/2005 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Ronson." * 02/11/2005 - Black & Decker Corp. files an application to register "Charlotte" in Class 006. * 02/11/2005 - Notice and trial dates sent to parties. * 02/11/2005 - GMA Accessories files a Motion for Summary Judgment. * 02/11/2005 - Notice of Opposition and trial dates sent to parties. * 03/15/2007 - Applicant, C. Ronson Inc., files a Motion for Reconsideration of Order Denying Summary Judgment. * 03/15/2008 - TTAB issues a decision on the matter (submitted on Brief 02/25/2008) and dismisses the opposition. * 03/15/2008 - The proceedings are suspended pending the disposition of a related civil action filed in the U.S. District Court for the Southern District of New York.	The matter is still pending.
GMA Accessories, Inc. v. BLJ Acquisitions I, LLC	TTAB: October 31, 2005	GMA Accessories	BLJ Acquisitions	BLJ Acquisitions filed an application on February 13, 2004 to register the mark "Charlotte Jumps Classics" in Classes 025 and 041.	* 02/11/2005 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Ronson." * 02/11/2005 - BLJ Acquisitions files an Opposition to the mark "Charlotte Ronson." * 02/11/2005 - Notice and trial dates sent to parties. * 02/11/2005 - GMA Accessories files a Motion for Summary Judgment. * 02/11/2005 - Notice of Opposition and trial dates sent to parties. * 02/11/2005 - GMA files a Motion for Summary Judgment. * 02/11/2008 - The proceedings are suspended pending the disposition of a related civil action filed in the U.S. District Court for the Southern District of New York.	The matter is still pending.
GMA Accessories, Inc. v. Daily Spanke, LLC	TTAB: November 25, 2005	GMA Accessories (potential opposite)	Daily Spanke	Daily Spanke filed an application on 12/15/2004 to register the mark "Charlotte Tanabata" in Class 025.	* 00/02/2005 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Tanabata." * 00/02/2005 - BLJ Acquisitions withdraws its registration application. * 00/02/2005 - BLJ Acquisitions files an application against the applicant pursuant to BLJ's abandonment of its application. * 11/03/2005 - GMA Accessories files an Opposition to the mark "Charlotte Tanabata." * 11/03/2005 - Notice of Opposition and trial dates sent to parties. * 11/03/2005 - BLJ Acquisitions files a Motion for Summary Judgment. * 11/03/2005 - Notice of Opposition and trial dates sent to parties. * 11/03/2005 - GMA files a Motion for Summary Judgment. * 11/03/2007 - GMA files a Motion for Summary Judgment. * 11/03/2007 - Proceedings are suspended.	The matter was terminated on December 4, 2005 after BLJ abandoned its application.
GMA Accessories, Inc. v. Wright Medical Technology, Inc.	TTAB: March 22, 2006	GMA Accessories & Athrotek, Inc. (potential opposite)	Wright Medical Technology, Inc.	Wright Medical Technology filed an application on November 18, 2004 to register the mark "Charlotte" in Class 10.	* 02/28/2006 - USPTO issues a Notice of Publication for the registration of mark "Charlotte." * 02/28/2006 - GMA requests and is granted an extension to file a notice of opposition because it engaged in settlement negotiations with the applicant, Wright Medical Technology. * 06/23/2006 - GMA requests and is granted a further extension to file a notice of opposition. * 06/23/2006 - GMA files a Notice of Opposition to the mark "Charlotte." * 06/28/2006 - Notice of Opposition and trial dates sent to parties. * 11/03/2007 - The parties request a dismissal of the Opposition proceeding pursuant to a settlement agreement. * 12/18/2007 - TTAB dismisses the Opposition with prejudice.	The matter is still pending.
GMA Accessories, Inc. v. Charlotte Thruway Limited	TTAB: May 25, 2006	GMA Accessories	Charlotte Thruway Limited	Charlotte Thruway filed an application on September 20, 2004 to register the mark "Charlotte Thruway" in Classes 003, 01, 016, 018, 021, 024, and 044.	* 02/25/2006 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Thruway." * 02/25/2006 - Notice of Opposition and trial dates sent to parties. * 02/25/2006 - GMA files a Motion for Summary Judgment. * 12/02/2008 - GMA's Motion for Summary Judgment is denied. * 03/20/2008 - The Opposition proceeding are temporarily suspended pending settlement negotiations between the parties.	The matter is still pending.

CASE NAME	Court & Filing Date	Plaintiff	Defendant	Motion of the Plaintiff	Proceeding Pending	Status
GMA Accessories, Inc. v. Arnick International LLC	TTAB; June 30, 2005	GMA Accessories	JJJ International LLC	Annick Gantel	Annick Gantel filed an application on March 19, 2003 to register the mark "Eau de Charlotte" in Class 025.	The proceeding is pending.
GMA Accessories, Inc. v. JJJ International LLC	TTAB; June 30, 2006	GMA Accessories	JJJ International LLC	JJJ International filed an application on February 14, 2003 to register the mark "Charlotte Candy" in Classes 014, 018, and 025.	• 07/11/2002 - USPTO issues a Notice of Publication for the registration of mark "Eau de Charlotte." • 06/10/2005 - GMA Accessories files a Petition for cancellation of the registration of "Eau de Charlotte." • 08/24/2005 - Motion to stay filed. GMA Accessories files a Motion to Withdraw its Petition for Cancellation. • 05/28/2008 - GMA Accessories files a Motion to Withdraw its Petition for Cancellation.	The proceeding for cancellation is pending.
GMA Accessories, Inc. v. Charlotte Brown	TTAB; June 30, 2006	GMA Accessories	Charlotte Brown	Charlotte Brown filed an application on October 30, 2000 to register the mark "Princess Charlotte" in Class 025.	• 07/11/2002 - USPTO issues a Notice of Publication for the registration of mark "Charlotte Candy." • 06/20/2005 - GMA Accessories files a Petition for cancellation of the registration of "Charlotte Candy." • 07/19/2006 - Notice of Default is sent to the parties. • 12/22/2007 - TTAB enters a Default Judgment against JJJ International and cancels its registration of the mark "Charlotte Candy." • 08/04/2008 - The Commissions for Trademarks cancels JJJ International's registration.	The matter was terminated on March 4, 2008.
GMA Accessories v. Job de Chauffe Ltd.	TTAB; June 30, 2006	GMA Accessories	Job de Chauffe Ltd.	Job de Chauffe filed an application on August 13, 2003 to register the mark "Job de Chauffe" in Class 025.	• 07/11/2004 - USPTO issues a Registration Certificate for the registration of mark "Princess Charlotte." • 06/10/2005 - USPTO issues a Registration Certificate for the registration of mark "Job de Charlotte." • 07/03/2005 - Notice of Publication and final dates sent to parties. • 08/23/2005 - GMA Accessories files a Petition for Cancellation of the registration of "Princess Charlotte." • 08/23/2005 - TTAB enters a Default Judgment against Job de Chauffe Ltd. and cancels its registration of the mark "Princess Charlotte." • 09/05/2005 - The Commissions for Trademarks cancels Job de Chauffe's registration.	The matter was terminated on October 24, 2008.
GMA Accessories v. Ehring Schmitz GmbH & Co. KG	TTAB; July 25, 2007	GMA Accessories	Ehring Schmitz GmbH & Co. KG	Ehring Schmitz filed an application on December 1, 2005 to register the mark "Charlotte" in Classes 014 and 025.	• 07/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte." • 06/10/2008 - GMA Accessories files a Petition for Cancellation of the mark "Job de Charlotte." • 07/03/2008 - Notice of Publication and final dates sent to parties. • 08/23/2008 - GMA Accessories files a Petition for Cancellation of the registration of "Job de Charlotte." • 08/23/2008 - TTAB enters a Default Judgment against Ehring Schmitz for failure to state claim. • 09/05/2008 - The Commissions for Trademarks cancels Job de Chauffe's registration.	The notice was terminated on October 05, 2008.
Charlotte Tilbury Ltd. et al v. GMA Accessories	TTAB; July 25, 2007	Charlotte Tilbury Ltd. et al	GMA Accessories	GMA Accessories filed an application on October 02, 2006 to register the mark "Charlotte" in Class 025.	• 07/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte." • 06/10/2008 - GMA Accessories files a Petition for Cancellation of the mark "Charlotte." • 07/03/2008 - Notice of Publication and final dates sent to parties. • 08/23/2008 - GMA Accessories files a Petition for Cancellation of the mark "Charlotte." • 08/23/2008 - TTAB enters a Default Judgment against Charlotte Tilbury Ltd. and cancels its registration of the mark "Charlotte." • 09/05/2008 - The Commissions for Trademarks cancels Charlotte Tilbury's registration.	The matter is still pending.
GMA Accessories v. Charlotte Meentzen Kaufenwelt	TTAB; January 9, 2008	GMA Accessories	Charlotte Meentzen Kaufenwelt	Charlotte Meentzen Kaufenwelt filed an application on October 17, 2006 to register the mark "Charlotte Meentzen" in Class 025.	• 07/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Meentzen." • 06/10/2008 - GMA Accessories requests and is granted an Extension of Time to file an Opposition. • 07/03/2008 - Crossed Inc. files an Opposition to the registration of the mark "Charlotte." • 11/06/2007 - Notice and final dates sent to parties. • 11/07/2007 - Charlotte Tilbury Ltd. files an Opposition to the registration of the mark "Charlotte." • 11/07/2007 - Notice and final dates sent to parties. • 01/17/2008 - GMA Accessories files a Motion to Dismiss for failure to state a claim. • 01/17/2008 - Proceedings are suspended pending resolution of the Motion to Dismiss. • 09/17/2008 - TTAB dismisses Charlotte Tilbury's Opposition to GMA's registration of the mark "Charlotte." • 09/17/2008 - The matter is terminated between Charlotte Tilbury, opposer, and GMA Accessories, applicant. • 03/21/2008 - Charlotte Tilbury files a Motion for Relief from Entry of Final Judgment.	The matter is still pending.
GMA Accessories v. TCG Holdings LLC	TTAB; January 9, 2008	GMA Accessories	TCG Holdings LLC	TCG Holdings filed an application on 01/09/2008 to register the mark "Charlotte Meentzen."	• 07/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Meentzen." • 06/10/2008 - GMA Accessories requests and is granted an Extension of Time to file an Opposition. • 07/03/2008 - TCG Holdings LLC requests a second extension to file an Opposition. • 09/14/2008 - TTAB denies request for an Extension.	The matter was terminated on March 14, 2008.
GMA Accessories v. TCG Holdings LLC	TTAB; February 5, 2008	GMA Accessories	TCG Holdings LLC	TCG Holdings filed an application on July 10, 2006 to register the mark "Charlotte Meentzen" in Class 025.	• 07/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Meentzen." • 06/10/2008 - GMA Accessories requests and is granted an Extension of Time to file an Opposition.	The matter has been terminated.
GMA Accessories v. TCG Holdings LLC	TTAB; February 6, 2008	GMA Accessories	TCG Holdings LLC	TCG Holdings filed an application on November 28, 2006 to register the mark "Charlotte Meentzen" in Class 025.	• 12/11/2007 - USPTO issues a Notice of Publication for the registration of the mark "Charlotte Meentzen." • 06/06/2008 - GMA Accessories requests and is granted an Extension of Time to file an Opposition.	The matter has been terminated.

EXHIBIT B

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

SANEI CHARLOTTE RONSON LLC,

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Plaintiff,

Civil Action No.: 07CV9578 (CM)

- against -

GMA ACCESSORIES, INC.,

Defendant.

-----X

MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT'S MOTION TO DISMISS

NATURE OF THE CASE

Sanei Charlotte Ronson, LLC (hereinafter "SANEI") is an applicant in the U.S.P.T.O. for the mark CHARLOTTE RONSON with respect to clothing, handbags and other goods. GMA Accessories, Inc. has been the registered owner of the mark CHARLOTTE for many years also with respect to clothing, handbags and other goods. GMA's CHARLOTTE mark has become incontestable with respect to the clothing and handbags and has been recognized as a strong mark with respect to clothing in a recent decision by Hon. Laura Taylor. Swain. See *GMA v. BOP*, 507 F.Supp.2d 361 (S.D.N.Y. 2007) (the SOLNICKI case).

SANEI premises much of its complaint upon accusations of bad faith prosecution of the SOLNICKI case pending under docket number 07CV3219(LTS), yet SANEI did not mark this case as related. Both GMA and SANEI have motions for summary judgment pending in the Trademark Trial and Appeal Board ("TTAB") where the parties are seeking a determination of the primary issue, i.e. does SANEI have the right to use CHARLOTTE RONSON.

FACTS

For a summary of the facts and exhibits, the Court is respectfully referred to the accompanying declaration of Andrew T. Sweeney.

POINT I

SANEI has not set forth an actual and immediate threat of a lawsuit and therefore its first claim for Declaratory Judgment Should be Dismissed

Only where a plaintiff has been threatened with federal trademark infringement litigation and where there is a question as to the validity of the trademark registration, may a plaintiff file a federal lawsuit for declaratory judgment. *Moog Controls, Inc. v. Moog, Inc.*, 923 F.Supp. 427, 432 citing 4 J. Thomas McCarthy, McCarthy On Trademarks And Unfair Competition (3d. ed. 1995) Section 32.21(2) at 32-76. “The federal declaratory judgment is not a prize to the winner of a race to the courthouses”. *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 219 (2d Cir. 1978).

“The Second Circuit has held that the filing of an opposition in a trademark registration proceeding ‘is not by itself a charge or warning of a future charge of infringement’ and therefore does not, without more, create an actual controversy.” *Progressive Apparel Group, Inc. v. Anheuser-Busch, Inc.*, 1996 WL 50277 (S.D.N.Y. 1996) (citing *Topp-Cola Co. v. Coca-Cola Co.*, 314 F.2d 124, 125-26 (2d Cir. 1963)).

Here the parties have been perfectly content to litigate in the TTAB where SANEI not too long ago filed a monstrous motion for summary judgment containing thousands of pages of exhibits which we were forced to oppose at great cost to GMA.

The SOLNICKI case cannot be viewed as a direct or indirect threat by GMA to SANEI. Indeed, CHARLOTTE SOLNICKI is an internationally known company whose use of the CHARLOTTE mark was widespread and highly publicized in Hollywood, on the internet and in the media. The fact that GMA will not grant permission for the defendants in the SOLNICKI case to sell CHARLOTTE RONSON goods cannot be viewed as a threat of imminent litigation upon SANEI. *See Progressive Apparel Group, Inc., v. Anheuser-Busch, Inc., supra* (maintaining that there is confusion between two marks does not constitute immediate threat).

GMA should not be forced to duplicate its efforts in another proceeding where, as here, it has not placed SANEI in imminent jeopardy of being sued and the matter is fully briefed before the TTAB. This Court is afforded ample discretion in its decision of whether to exercise jurisdiction. *See e.g. Bausch & Lomb Inc. v. CIBA*, 39 F.Supp.2d 271, 274-75 (W.D.N.Y. 1999) (String Citing) (“even if there is an actual controversy and thus jurisdiction, the exercise of that jurisdiction rests within the sound discretion of the district court”). Accordingly, it is respectfully requested that the Court decline to exercise declaratory jurisdiction here.

POINT II

“Trademark misuse” is not a cause of action and this claim should be dismissed

SANEI’s second claim alleges “trademark misuse.” However, courts that have addressed the issue have consistently held that “trademark misuse” is not a cognizable affirmative claim and should be dismissed. See e.g. *Ford Motor Co. v. Obsolete Ford Parts, Inc.*, 318 F.Supp.2d 516, 521 (E.D. Michigan 2004) (“the court declines to announce or create an independent cause of action for trademark misuse”); *Dunn Computer Corp. v. Loudcloud, Inc.*, 133 F.Supp.2d 823, 830 (E.D. Virginia 2001) (“plaintiff concedes that trademark misuse is only an affirmative defense, not an independent cause of action”); *Whitney Information Network, Inc. v. Gagnon*,

353 F.Supp.2d 1208 (M.D. Florida 2005) (“no authority in the Eleventh Circuit or elsewhere allowing trademark misuse as an independent unfair competition cause of action”).

POINT III

The Third and Fourth Claims Should be Dismissed for Failing to Comply with virtually every aspect of Rule 9(b)

“When the complaint contains allegations of fraud, however, Fed.R.Civ.P. 9(b) requires that ‘the circumstances constituting fraud … be stated with particularity.’ We have stated that ‘the complaint must: (1) specify the statements that the plaintiff contends were fraudulent, (2) identify the speaker, (3) state where and when the statements were made, and (4) explain why the statements were fraudulent.’” *Acito v. IMCERA Group, Inc.*, 47 F.3d 47 (2nd Cir. 1995). “Rule 9(b) is intended ‘to provide a defendant with fair notice of a plaintiff’s claim, to safeguard a defendant’s reputation from ‘improvident charges of wrongdoing,’ and to protect a defendant against the institution of a strike suit’. *Id.* See also, *O’Brien v. National Property Analysts Partners*, 936 F.2d 674 (2nd Cir. 1991) (Rule 9(b) is designed to “safeguard a defendant’s reputation from ‘improvident charges of wrongdoing,’ and to protect a defendant against the institution of a strike suit”).

In trademark cases, “Rule 9(b) requires that each allegedly fraudulent statement be identified with particularity, and that specific reference be made to the time, location, content and speaker of each statement. In addition, the party alleging fraud must specify in what respects each of the statements were false and misleading, and the factual basis for believing the defendant acted fraudulently and was responsible.” *Great Lakes Mink Ass’n v. Furrari, Inc.*, 1987 WL 33592 (S.D.N.Y. 1987) (citing cases). See also *GMA Accessories, Inc. v. Idea Nuova, Inc.*, 157 F.Supp.2d 234, 243 (S.D.N.Y. 2000); *Kash ‘N Gold, Ltd. v. Samhill Corp.*, 1990 WL

196089 (S.D.N.Y. 1990).

The conclusory allegations do not satisfy any of the requirements of Rule 9(b). SANEI refers to Charlotte Russe (who GMA had a brief dispute with which resulted in a co-existence agreement); Charlotte Tarantola (which does not hold a registration and which GMA has a proceeding against in the TTAB); Charlotte Corday (which defaulted in a TTAB proceeding brought by GMA); and Charlotte Ford (which registration was expired well before GMA's application though it was not officially cancelled until shortly thereafter).

However, SANEI does not (and cannot) allege that any of these parties had a "right" to the CHARLOTTE mark that was senior to GMA's and that GMA believe that this right was superior, both of which must be pled in order for plaintiff to properly allege that GMA committed fraud. See e.g. *King Size, Inc. v. Frank's King Size Clothes, Inc.*, 547 F.Supp. 1138 (S.D. Tex. 1982) (defendant must prove that trademark applicant itself believed that other's rights were superior and concealed those rights).

Accordingly both fraud claims should be dismissed.

POINT IV

The fraud claims would also fail because they do not allege injury

In addition, SANEI has failed to plead essential elements of their fraud claims – "causation and damages – at all, much less with particularity" which would itself be grounds for their dismissal. *GMA Accessories, Inc. v. Idea Nuova, Inc.*, 157 F.Supp.2d 234, 243 (S.D.N.Y. 2000). *See Kaye v. Grossman*, 202 F.3d 611, 614 (2nd Cir. 2000) (there must be a loss as a "direct , immediate and proximate result" of the alleged fraud). Here SANEI fails to allege how the fraud that it failed to plead caused injury to SANEI.

POINT V

Sanei's 2d, 3d and 4th claims would not be able to be brought in any event because they lack jurisdiction

"The court is without jurisdiction to hear a 15 U.S.C. Section 1119 claim when there is no other justiciable controversy between the parties involving the defendant's mark." *Thomas & Betts Corp.*, 48 F. Supp.2d 1088 (N.D. Ill. 1999). *See also Diti v. Coldwell Banker Residential Affiliates, Inc.*, 954 F.2d 869, 874 (3d Cir. 1992) (Section 37 (15 U.S.C. 1119) is not intended "to provide a cancellation remedy in the absence of an underlying basis of jurisdiction.").

Judge Curtin from the Western District of New York had occasion to analyze a situation where a defendant had "neither filed nor threatened a federal lawsuit" based on a registered trademark but an action was nevertheless initiated against it for cancellation pursuant to 15 U.S.C. 1119. *Moog Controls, Inc. v. Moog, Inc.* 923 F.Supp. 427, 431 (W.D.N.Y. 1996). Even though the defendant in that case had a federally registered trademark which plaintiff sought to cancel pursuant to the statute, in dismissing for lack of subject matter jurisdiction, Judge Curtin noted,

[T]he provisions of Section 1119 granting the Court authority to determine the right to registration and order cancellation assume a properly instituted and otherwise jurisdictionally supported action involving a registered trademark. *Universal Sewing Machine Co. v. Standard Equipment Corp.*, 185 F.Supp. 257 (S.D.N.Y. 1960). In other words, when seeking cancellation offensively and relying solely upon that claim for federal jurisdiction would seem to be relegated to first exhausting his administrative remedies before resorting to the Courts. Such a situation, exemplified by the instant action, must be distinguished from the cases where there is present some independent basis of federal jurisdiction, and wherein the validity of a registered trademark is brought into issue, for example, by way of defense or counterclaim. *Id.* at 259.

Moog Controls, Inc. v. Moog, Inc., supra.

Here Sanei seeks to use 15 U.S.C. 1119 offensively in its second, third and fourth claims and as such they lack federal jurisdiction.

POINT V

SANEI has not set forth a claim for unfair competition

"The gravamen of a claim of unfair competition is a bad faith misappropriation of a commercial advantage belonging to another by infringement or dilution of trademark or trade name or by exploitation of proprietary information or trade secrets." *Frink America, Inc. v. Champion Road Machinery Limited*, 62 F.Supp.2d 679, 685 (N.D.N.Y. 1999). SANEI's sixth claim does not even allege that GMA infringed a trademark or trade name and therefore this claim should be dismissed.

POINT VI

The plaintiff's only remaining claim (fifth claim) lacks federal jurisdiction

The fifth claim is the only claim that is pled adequately in SANEI's complaint is one for relief under state law, i.e. tortious interference with prospective economic relations.¹ Inasmuch as diversity is lacking between the parties, this claim cannot survive.

Dismissal of pendant state claims pursuant to Fed.R.Civ.P. 12(b)(1) is proper where the claimant has no other grounds for federal jurisdiction. *United Mine Workers of America v. Gibbs*, 385 U.S. 715, 726, 86 S.Ct. 1130, 16 L.Ed.2d 218 (1966); *In Re Merrill Lynch, Ltd. Partnerships Litigation*, 154 F.3d 56, 61 (2d Cir. 1998); *Keith v. Black Diamond Advisors, Inc.*, 48 F.Supp.2d 326, 335 (S.D.N.Y. 1999).

¹ This claim is patently frivolous because it wildly accuses GMA of suing retailers of CHARLOTTE SOLNICKI merchandise specifically in order to injure CHARLOTTE RONSON rather than to protect the CHARLOTTE mark.

CONCLUSION

For the foregoing reasons, it is respectfully requested the first and fifth claims be dismissed for lack of jurisdiction; that the second, third, fourth and sixth claims be dismissed for failure to state a claim and lack of jurisdiction; and that the complaint herein be dismissed in its entirety.

Dated: New York, New York
November 19, 2007

Respectfully submitted,

THE BOSTANY LAW FIRM

By: 

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40 Wall Street, 61st Floor
New York, N.Y. 10005
(212) 530-4400

EXHIBIT C

Ex. C - Charlotte Ronson Decision to Deny Motion to Dismiss (J. McMahon).txt

1

1 82F8SANC
1 UNITED STATES DISTRICT COURT
1 SOUTHERN DISTRICT OF NEW YORK
2 -----x
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3 SANEI CHARLOTTE RONSON LLC,
3
4 Plaintiff,
4
5 v. 07 Cv. 9578 (CM)
5
6 GMA ACCESSORIES, INC.,
6
7 Defendant.
7
8 -----x
8
9 February 15, 2008
9 10:30 a.m.
10
10 Before:
11
11 HON. COLLEEN McMAHON
12
12 District Judge
13
13 APPEARANCES
14
14 DREIER LLP
15 Attorneys for Plaintiff
15 IRA S. SACKS
16 MARY GRIECO
16 SAFIA A. ANAND
17
17 ORRICK, HERRINGTON & SUTCLIFFE LLP
18 Attorneys for Plaintiff
18 LISA T. SIMPSON
19
19 THE BOSTANY LAW FIRM
20 Attorneys for Defendant
20 JOHN P. BOSTANY
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24
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SOUTHERN DISTRICT REPORTERS, P.C.
(212) 805-0300

□

2

1 82F8SANC 1 (Case called)
2 THE DEPUTY CLERK: Parties, please state your
3 appearances.
4 MR. SACKS: Good morning, your Honor. Ira Sacks from
5 Dreier LLP. With me from Dreier is Safia Anand and Mary
6 Grieco.
7 MS. SIMPSON: Lisa Simpson from Orrick, Herrington &
8 Sutcliffe, also here on behalf of Sanei.
Page 1

Ex. C - Charlotte Ronson Decision to Deny Motion to Dismiss (J. McMahon).txt
9 MR. BOSTANY: John Bostany for the defendant.
10 THE COURT: The motion to dismiss is denied.
11 That's the only reason we have the court reporter
12 here.
13 (Adjourned)
14
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21
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23
24
25

SOUTHERN DISTRICT REPORTERS, P.C.
(212) 805-0300

□

EXHIBIT D

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,535,454
Registered Feb. 5, 2002

**TRADEMARK
PRINCIPAL REGISTER**

CHARLOTTE

GMA ACCESSORIES, INC. (NEW YORK CORPORATION)
1 EAST 33RD STREET, 9TH FLOOR
NEW YORK, NY 10016

FOR: CLOTHING, FOOTWEAR AND HEAD-
GEAR, NAMELY HATS, SCARVES, GLOVES AND
SOCKS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 11-15-1996; IN COMMERCE 11-15-1996.

OWNER OF U.S. REG. NOS. 221,405 AND 2,217,341.

SER. NO. 75-857,222, FILED 11-24-1999.

ELLIOTT ROBINSON, EXAMINING ATTORNEY

EXHIBIT E

Int. Cl.: 18

Prior U.S. Cls.: 1, 2, 3, 22 and 41

Reg. No. 2,217,341

Registered Jan. 12, 1999

United States Patent and Trademark Office

**TRADEMARK
PRINCIPAL REGISTER**

CHARLOTTE

GMA ACCESSORIES, INC. (NEW YORK COR-
PORATION)
1 EAST 33RD STREET, 9TH FLOOR
NEW YORK, NY 10016

FOR: SACKS AND BAGS, NAMELY, HAND-
BAGS MADE OF TEXTILES AND BEADS, IN
CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 11-0-1996; IN COMMERCE
11-0-1996.

SER. NO. 75-403,211, FILED 12-10-1997.

JILL C. ALT, EXAMINING ATTORNEY

EXHIBIT F

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-11 15:26:28 ET

Serial Number: 73199969 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1135037

Mark (words only): CHARLOTTE

Standard Character claim: No

Current Status: Registration canceled under Section 8.

Date of Status: 2001-05-19

Filing Date: 1979-01-15

Transformed into a National Application: No

Registration Date: 1980-05-13

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2000-08-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ZYLOWARE CORPORATION

Address:

ZYLOWARE CORPORATION

11-15 47TH AVE.

LONG ISLAND, NY 11101

United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 009

Class Status: Section 8 - Cancelled

EYEGLASS FRAMES AND PARTS THEREOF

Basis: 1(a)

First Use Date: 1979-01-02

First Use in Commerce Date: 1979-01-02

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-07-02 - Attorney Revoked And/Or Appointed

2006-07-02 - TEAS Revoke/Appoint Attorney Received

2006-07-02 - TEAS Change Of Correspondence Received

2001-05-19 - Canceled Section 8 (10-year)/Expired Section 9

1985-10-07 - Section 8 (6-year) accepted & Section 15 acknowledged

1985-06-19 - Section 8 (6-year) and Section 15 Filed

ATTORNEY/CORRESPONDENT INFORMATION

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